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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,802	07/18/2005	Guenter Farin	266130US6PCT	1166
22850 7590 01/03/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHEN, VICTORIA W	
			ART UNIT	PAPER NUMBER
			3739	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/03/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/525,802

Applicant(s)

FARIN ET AL.

Examiner

Victoria W. Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/25/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the fastening support pipe in claims 36 and 37 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities: Applicant references claim numbers within the specification on pg. 1, ln. 4, pg. 3, ln. 18. It is

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improper to refer to the claims in the specification because they are often changed or renumbered. Examiner also notes that a preliminary amendment has been received that has changed the numbering of the claims. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 recites “An applicator for an electrosurgical instrument, alternatively for argon-plasma coagulation and cutting.” The word “alternatively” makes it unclear whether Applicant is claiming the device is used for argon-plasma coagulation and cutting or for another purpose. Appropriate correction is required.

Claim 24 recites the limitation "current supply pipe" in ln. 1. There is insufficient antecedent basis for this limitation in the claim. It is unclear whether this pipe is the same as the previously claimed “gas and high frequency current supply pipe” or a different, distinct pipe.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20, 21, 23, 26, 34-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleenor (US Pat No 5306238). For this reference, Examiner considers the end of the instrument with the electrode tip as the proximal end, and the end of the instrument with the gas and current terminal as the distal end.

Regarding claims 20 and 26, Fleenor discloses an electrosurgical apparatus with a gas and high frequency current terminal [64, Fig. 2], a cutting electrode [12], gas and current supply pipe [82], insulating cap [20], insulating tube [14 & 18], right angle bend [25], and radially surrounding gas-sealing inhibiting device, in this case an O-ring [col. 6, ll. 26-29].

Regarding claim 21, the inhibiting device is disclosed as being located in a proximal extension of the cap [84, Fig. 1].

Regarding claims 23 and 34, Fleenor discloses a consumption-resistant hollow cylindrical, partially outwardly projecting insert, made of ceramic, arranged at a proximal end of the casing tube [15, col. 5, ll. 63-65].

Regarding claim 35, Fleenor discloses the electrode as being attached at a proximal end of the inside of the gas and current supply pipe [Fig. 1, col. 5, ll. 54-62].

Regarding claim 36 and 37, Fleenor discloses a fastening support pipe where the pipe adjusts the electrode for achieving optimal surrounding gas flow [col. 5, ll. 66-68, col. 6, ll. 1-20].

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant

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for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 20 rejected under 35 U.S.C. 102(e) as being anticipated by Cunningham et al. (US Pat No 6558383 B2).

Regarding claim 20, Cunningham discloses an electrosurgical instrument with a gas [69] terminal, current terminal [106], cutting electrode [68], gas and current pipe [64], an insulating cap [12, col. 4, ll. 29-32], an insulating casing tube [18, col. 5, ll. 58-59] with a collar at the distal end [Fig. 7, near labeled element 48], and a radially surrounding gas-sealing inhibiting device [col. 6, ll. 39-43].

Claims 20, 35 rejected under 35 U.S.C. 102(e) as being anticipated by Mackay (US Pat No 7004939 B2).

Regarding claim 20, Mackay discloses an electrosurgical instrument with a gas [204] terminal, current terminal [203], cutting electrode [212], gas and current pipe [408], an insulating cap [403], an insulating casing tube [401] with external right angle at the distal end [Fig. 4, labeled 401], and a radially surrounding gas-sealing inhibiting device [213].

Regarding claim 35, Mackay discloses the cutting electrode is attached at a proximal end of the inside of the gas and current pipe [Fig. 5].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fleenor in view of Cosmescu (US Pat No 5836909). Fleenor discloses everything as previously described, except for a radially surrounding groove for accommodating an inhibiting device on the current supply pipe. Cosmescu teaches the use of an O-ring to prevent gas from escaping during a surgical procedure [142, Fig. 5a], wherein the O-ring is located in a groove around a supply pipe. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to use the O-ring as taught by Cosmescu to modify the invention disclosed by Fleenor in order to prevent gas from escaping during a surgical procedure. Cosmescu does not teach the groove being on the casing tube. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to put the groove on the casing tube because Applicant has not disclosed that putting the groove on the casing tube provides an advantage over a groove on the supply pipe. One of ordinary skill in the art would have expected Applicant's invention to perform equally as well with either location of the groove because both locations perform the same function of preventing gas leakage and providing a friction fit. Therefore, it would have been an obvious matter of design choice to modify Cosmescu to obtain the invention as specified in claim 25.

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***Allowable Subject Matter***

Claims 22, 27-33 and 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20020022838 A1	US-PGPUB	Cunningham, James Steven et al.	Inert gas enhanced electrosurgical apparatus
US 6958063 B1	USPAT	Soll; Joachim et al.	Plasma generator for radio frequency surgery
US 6780184 B2	USPAT	Tanrisever; Naim Erturk	Quantum energy surgical device and method
US 6679880 B2	USPAT	Yang; Liang-Pang et al.	Electrosurgical hand piece
US 6475215 B1	USPAT	Tanrisever; Naim Erturk	Quantum energy surgical device and method
US 6142995 A	USPAT	Cosmescu; Ioan	Electro-surgical unit pencil apparatus having a removable shroud
US 6149648 A	USPAT	Cosmescu; Ioan	Electro-surgical unit-argon beam coagulator pencil apparatus and method for operating same
US 5693044 A	USPAT	Cosmescu; Ioan	Telescopic surgical device and method therefor
US 5088997 A	USPAT	Delahueraga; Louis et al.	Gas coagulation device
US 6602249 B1	USPAT	Stoddard; Robert Bryant et al.	Electrosurgical gas attachment



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US 4781175 A      USPAT McGreevy; Francis T. et al.      Electrosurgical conductive  
gas stream technique of achieving improved eschar for coagulation

US 5098430 A      USPAT Fleenor; Richard P.      Dual mode electrosurgical pencil

US 4901719 A      USPAT Trenconsky; Robert P. et al.      Electrosurgical conductive  
gas stream equipment

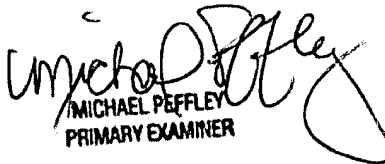
US 4711238 A      USPAT Cunningham; Frank W.      Meniscal cutting device

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Victoria W. Chen whose telephone number is (571) 272-  
3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for  
the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the  
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VWC  
12/21/06

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER